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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/046,277 | 01/16/2002 | Hisakazu Hojo | 020048 | 2379 |
| 23850 | 7590 | 02/18/2004 | EXAMINER | |
| ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP | | | PRATT, HELEN F | |
| 1725 K STREET, NW | | | ART UNIT | |
| SUITE 1000 | | | PAPER NUMBER | |
| WASHINGTON, DC 20006 | | | 1761 | |

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,277

Applicant(s)

HOJO ET AL.

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Claims 8-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper dated 1-9-04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al. (6,572,908) or Buddemeyer et al.(6,248,376).

Kemp et al. disclose a composition containing a polyvalent metal such as a metal hydroxide, oxide, carbonate or bicarbonate, such calcium hydroxide, a phosphoric acid and an organic acid such as succinic acid which can be used as a food additive (abstract and col. 10, lines 5-16). Claims 1-3, 7 and 11 differ from the reference in the use of an alkali metal and in the particular amount of alkali metal and in the amount of alkali metal and in the electrical conductivity as in steps 1a and b. However, it is seen that the alkali metal can also be sodium or potassium hydroxide (page 12, last 3 lines). The reference discloses that a monovalent or divalent metal base can be used (col. 9,

Art Unit: 1761

lines 25-35). Therefore, it would have been obvious to substitute the polyvalent metal for a monovalent metal or it would have been obvious to use the polyvalent metal since the reference discloses that they are equivalent. The particular amount of alkali metal is seen to have been within the skill of the ordinary worker to vary as the composition is shown. Also, the electrical conductivity is seen to have been shown as the composition is known. Therefore, it would have been obvious to use particular amounts of alkali metal and a particular electrical conductivity as the composition has been shown.

Buddemeyer et al. disclose that it is known to make a calcium enriched composition using a composition containing phosphate ions, citrate ions, calcium ions, and a metal hydroxide and water in food products as in claims 1-3 (abstract). Claims 1-3 differ from the references in the amount of alkali metal and in the particular electric conductivity. However, Buddemeyer et al. disclose a composition containing 7.16% alkali metal, which is seen to have been within the claimed amount (col. 15, lines 10-20). As the composition has been shown, it is seen that the electrical conductivity has been shown. Therefore, it would have been obvious to make the composition as claimed as shown by Buddemeyer et al.

Claim 4 further requires that the phosphoric compound can be calcium phosphate. Such is disclosed by Kemp et al. as the phosphoric acid would have reacted with the calcium succinate (col. 10, lines 5-16). The same is true in Buddemeyer et al. (col. 14, lines 14-50). Claim 4 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of

Art Unit: 1761

such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. Therefore, it would have been obvious to make a composition containing calcium phosphate.

Claim 6 further requires that the composition is a particular size.

However, nothing is seen at this time that the diameter of the compositions of the above references are not of the claimed size. Therefore, it would have been obvious to add an additive to the composition of the claimed size.

Claims 5 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over the above combined references as applied to claims 1-4, 6, 7, 11 above, and further in view of *Ndife et al.* (5,489,440).

Claim 5 further requires an emulsification stabilizer in particular amounts and claim 12 a composition containing an emulsification stabilizer. *Ndife et al.* disclose an oral rehydration solution containing minerals and a stabilizer (col. 10, lines 1-10). Nothing is seen that the stabilizer would not be an emulsifying stabilizer. Even though the mineral compositions of the references are not the same compositions as that of the claims, minerals are shown by the reference to need a stabilizer (col. 6, lines 58-70, col. 7, lines 1-25). Therefore, it would have been obvious to add a stabilizer for minerals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

Art Unit: 1761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 2-10-04

H. Pratt
HELEN PRATT
PRIMARY EXAMINER